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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,284

03/03/2004

Kil-soo Jung

1293.1770

8962

49455 7590 04/01/2009

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EXAMINER

HASAN, SYED Y

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/791,284	<b>Applicant(s)</b> JUNG ET AL.	
	<b>Examiner</b> SYED Y. HASAN	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 - 7 and 16 - 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 7 and 16 - 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/12/2004 and 1/28/2008</u> .                                | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 - 7 and 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 8 of copending Application No. 10/921,256. Although the conflicting claims are not identical,

and that the claimed language of the present Application is somewhat different from the language recited in claims 1 - 8 of copending Application No. 10/921,256, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that claims 1 - 8 of copending Application No. 10/921,256, would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the copending application.

With regard to claim 1, Applicant's attention is directed to claims 1 of the copending Application No. 10/921,256.

With regard to claim 2, Applicant's attention is directed to claims 2 of the copending Application No. 10/921,256.

With regard to claim 3, Applicant's attention is directed to claims 3 of the copending Application No. 10/921,256.

With regard to claim 4, Applicant's attention is directed to claim 4 of the copending Application No. 10/921,256.

With regard to claim 5, Applicant's attention is directed to claim 5 of the copending Application No. 10/921,256.

With regard to claims 6, Applicant's attention is directed to claims 2, 6 and 8 of copending Application No. 10/921,256.

With regard to claim 7, Applicant's attention is directed to claims 3, 6 and 8 of the copending Application No. 10/921,256

With regard to claim 18, Applicant's attention is directed to claims 2 and 3 of the copending Application No. 10/921,256

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1 - 7 are provisionally rejected on the ground of nonstatutory

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obviousness- type double patenting as being unpatentable over claims 1, 3, 6 - 7, of copending Application No. 11/435,872. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in claims 1, 3, 6 - 7, of copending Application No. 11/435,872, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that claims 1, 3, 6 - 7, of copending Application No. 11/435,872, would be able to perform the functions of the claimed limitations of the present Application.

With regard to claim 1, the feature of mainstream data and using a clock reproducing the sub audio data is present in claim 1 of the copending Application No. 11/435,872.

With regard to claim 2, the feature of using a clock reproducing the sub audio data is present in claim 1 of the copending Application No. 11/435,872.

With regard to claims 3 and 5, the feature of using a second clock decoding the depacketized sub audio data is present in claim 3, the copending Application No. 11/435,872.

With regard to claim 4, the feature of the still image data is present in claim 1 of the copending Application No. 11/435,872.

With regard to claim 6, the feature of the arrival time clock is present in claim 6 – 7, of the copending Application No. 11/435,872.

With regard to claims 7, Applicant's attention is directed to claim 6 - 7 of copending Application 11/435,872.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21 (2) of such treaty in the English language.

5. Claims 1 – 7 and 16 – 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Jung et al (P.N. 2005/0108506).

With regard to **claim 1**, Jung et al discloses a video decoding apparatus that shows all the limitations recited in claim 1, including the feature of a reproducing unit to reproduce mainstream data and sub audio data separately added in the mainstream data, wherein the reproducing unit comprises a counter used in reproducing the sub audio data. Applicant's attention is directed to claim 2 of Jung et al.

With regard to **claim 2**, the feature of wherein the counter includes a sub audio arrival time clock (ATC) counter used to depacketize the sub audio data as specified thereof in Jung et al (See Jung et al's Figure 9, components 906, 907).

With regard to **claim 3**, the feature of wherein the counter further comprises a sub audio system time clock (STC) counter used to decode the depacketized sub audio data as specified thereof in Jung et al (See Jung et al's Figure 9, components 750, 770).

With regard to **claim 4**, the feature of the mainstream data comprises still image

data as specified thereof is present in Jung et al. (See Jung et al's claim 2).

With regard to **claim 5**, the feature of a mainstream reproducing unit to reproduce mainstream data including still image data, using a clock for mainstream data; and a sub audio reproducing unit to reproduce sub audio data separately added into the mainstream data, using a clock for sub audio data as specified thereof is present in Jung et al (See Jung et al's Figure 9).

With regard to **claim 6**, the feature of a mainstream depacketizer that depacketizes the mainstream data, and a mainstream ATC counter which is used in depacketizing the mainstream data with the mainstream depacketizer; and the sub audio reproducing unit comprises: a sub audio depacketizer that depacketizes the sub audio data, and a sub audio ATC counter which is used in depacketizing the sub audio data with the sub audio depacketizer as specified thereof is present in Jung et al. (See Jung et al's Figure 9).

With regard to **claim 7**, the feature of a mainstream decoder that decodes the mainstream data output from the mainstream depacketizer, and a mainstream STC counter that provides a clock used in decoding the mainstream data with the mainstream decoder; and the sub audio reproducing unit further comprises: a sub audio decoder that decodes the sub audio data output from the sub audio depacketizer, and a sub audio STC counter that provides a clock used in decoding the sub audio data with the sub audio decoder as specified thereof is present in Jung et al (see Jung et al's Figure 9)

With regard to **claim 16**, the feature of a computer readable recording medium

storing a program executing a reproducing method, comprising: reproducing sub audio data separately added in mainstream data, using a clock reproducing the sub audio data as specified thereof in Jung et al (see Jung et al's claims 1 and 4 and para 0102)

With regard to **claim 17**, the feature of a computer readable recording medium storing a program executing a reproducing method, wherein the reproducing method comprises: reproducing mainstream data including still image data using a clock reproducing the mainstream data; and reproducing sub audio data separately added into the mainstream data using a clock reproducing the sub audio data as specified thereof in Jung et al (see Jung et al's claims 1 and 4 and para 0102)

With regard to **claim 18**, the feature of a reproducing apparatus reproducing video and audio data streams recorded on a recording disc, comprising: a first reproducer reproducing a first data stream based on first counters; and a second reproducer reproducing a second data stream based on second counters as specified thereof in Jung et al (see Jung et al's claims 2 and 3)

With regard to **claim 19**, the feature of the apparatus, wherein when the first and second counters are independently adjusted without affecting each other as specified thereof in Jung et al (see Jung et al's claims 1 and 4 and para 0102)

With regard to **claim 20**, the feature of the apparatus, wherein the first counters comprise a first arrival time clock counter and a first system time clock counter, and the second counters comprise a second arrival time clock counter and a second system time clock counter which are initialized based on program clock reference information in the first and second data stream as specified thereof in Jung et al (see Jung et al's



fig 9, 910 and 911)

With regard to **claim 21**, the feature of the apparatus, wherein the first reproducer comprises: a first buffer which captures the first data stream; a first source depacketizer which depacketizes the first data stream based on a count of the first arrival time clock counter; a demultiplexer which demultiplexes the depacketized first data stream; and a first decoder decoding the demultiplexed first data stream based on a count of the first system time clock counter as specified thereof in Jung et al (see Jung et al's fig 9)

With regard to **claim 22**, the feature of the apparatus, wherein the first data stream comprises mainstream data, and the second data stream comprises sub audio data as specified thereof in Jung et al (see Jung et al's fig 9, 902 and 903)

With regard to **claim 23**, the feature of the apparatus, wherein the mainstream data comprises still image data as specified thereof in Jung et al (see Jung et al's fig 7 and 10A and B and claim 2)

With regard to **claim 24**, the feature of the apparatus, wherein the mainstream data comprises a browsable slide show as specified thereof in Jung et al (see Jung et al's fig 7, 8 and 10A and B and claim 2)

With regard to **claim 25**, the feature of the apparatus, wherein the first decoder comprises: an audio decoder which decodes audio data; a sub picture decoder which decodes sub picture data; and a video decoder which decodes video data as specified thereof in Jung et al (see Jung et al's para 0028)

With regard to **claim 26**, the feature of the apparatus of claim, wherein when the

mainstream data comprises a browsable slide show the audio decoder is inactive as specified thereof in Jung et al (see Jung et al's para 0027)

With regard to **claim 27**, the feature of the apparatus, wherein the second reproducer comprises: a second buffer which captures the second data stream; a second source depacketizer which depacketizes the second data stream based on a count of the second arrival time clock counter; a second decoder decoding the depacketized second data stream based on a count of the second system time clock counter as specified thereof in Jung et al (see Jung et al's fig 9)

With regard to **claim 28**, the feature of the apparatus of claim 27, wherein the first data stream comprises mainstream data, and the second data stream comprises sub audio data as specified thereof in Jung et al (see Jung et al's fig 9, 902 and 903)

With regard to **claim 29**, the feature of the apparatus, wherein the second data stream comprises sub audio data which is reproduced regardless of the first data stream reproduction as specified thereof in Jung et al (see Jung et al's fig 8, 750, 770)

With regard to **claim 30**, the feature of the apparatus, wherein the second data stream is separately added to the first data stream on the recording disc as specified thereof in Jung et al (see Jung et al's abstract)

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the

invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Claims 1, 2, 4, 23 - 26, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Nonomura et al (P.N. 2003/0108338).

Nonomura et al discloses a reproducing apparatus that shows all the limitations recited in **claims 1 and 2** including the feature of a reproducing unit to reproduce mainstream data and sub audio data separately added in the mainstream data, wherein the reproducing unit comprises a counter used in reproducing the sub audio data and the counter includes a sub audio arrival time clock (ATC) counter used to depacketize the sub audio data. Applicant's attention is directed to Nonomura et al's page 11, paragraphs [0225- 0226].

With regard to **claim 4**, the feature of the mainstream being still image data as specified thereof is present in Nonomura et al. (See Nonomura et al's page 4, paragraph [0095], and page 7, paragraphs [0154]-[0155]).

With regard to **claim 25**, the feature of the apparatus, wherein the first decoder comprises: an audio decoder which decodes audio data; a sub picture decoder which decodes sub picture data; and a video decoder which decodes video data (fig 23, 104, 103, and 88, audio, sub-picture and video detectors)

**Claim 23** is rejected based on claim 4 above

**Claim 24** is rejected based on fig 15 , browsable slide show

**Claim 26** is rejected based on fig 15 , browsable slide show and audio #3 showing no-continue 'inactive'

**Claims 29 and 30** is rejected based on claim 1 above

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3, 5, 16 – 20, 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonomura et al (P.N. 2003/0108338) in view of Boyle (P.N. 2003/0223735).

Nonomura et al discloses a reproducing apparatus that shows substantially the same limitations recited in **claims 3 and 5**, including the feature of using a clock reproducing the sub audio data as specified in present claims 2 and 5. (See Nonomura et al's page 11, paragraphs [0225]-[0226]).

Nonomura et al fails to specifically disclose the feature of using the (STC) clock decoding the depacketized sub audio data as specified in the present claims 3, 5.

Boyle discloses the feature of using the (STC) clock decoding the depacketized sub audio data as specified in the present claims 3, 5. (See Boyle's page 1, paragraph [0008]).

It would have been obvious to one skilled in the art to modify the Nonomura et al's apparatus wherein the sub audio data decoding means provided thereof would incorporate the capability of a second clock for the purpose of decoding the depacketized sub audio data in the same conventional manner as is shown by Boyle. The motivation is to increase the quality of the reproduced data by avoiding jitter in the decoded data as suggested by Boyle.

**Claim 16** is rejected based on claims 1 – 3 above and para 0102 representing a computer readable media, CD-ROM

**Claim 17** is rejected based on claims 1 and 5 above and para 0102 representing a computer readable media, CD-ROM

**Claim 18** is rejected based on claims 1 – 3 above

**Claim 19** is rejected based on claim 1 for first counter and claim 3 for second counter and since they are in different embodiments therefore they are adjusted without effecting each other.

**Claim 20** is rejected based on claim 2 for first counter and claim 3 for second counter.

**Claims 22 and 28** is rejected based on claims 1 and 5 above

10. Claims 6, 7, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nonomura et al (P.N. 2003/0108338) and Boyle as applied to claims 3, and 5, above, and further in view of the admitted prior art shown in Figures 1-6 of the present Application.

The proposed combination of Nonomura et al and Boyle indicated above discloses a video reproducing apparatus that shows substantially the same limitations recited in claims 6, and 8, including the feature of using clock for reproducing the mainstream data and the audio data as specified thereof. (See the above rejection of claims 3 and 5).

With regard to **claim 6**, the proposed combination fails to specifically disclose the feature of using the arrival time clock for depacketizing the mainstream data and the sub audio data as specified in the present claims 6, and 8.

The admitted prior art disclosed in Figures 5, component 540, of the present Application does show such a feature of using the arrival time clock for depacketizing the mainstream data and the sub audio data as specified in the present claims 6, and 8.

It would have been obvious to one skilled in the art to modify the proposed combination of Nonomura et al and Boyle indicated above wherein the depacketizing/decoding means provided thereof would incorporate the capability of using an arrival time clock for the purpose of depacketizing the mainstream data and the sub audio data in the same conventional manner as is shown in the admitted prior art. The motivation is better the synchronize the reproduced data as suggested in the prior art.

With regard to **claim 7**, the feature of demultiplexing recited thereof is present in the proposed combination indicated above. (See the admitted prior art Figure 6, component 610, of the present Application).

**Claim 21** is rejected based on claim 6 for depacketizer and claim 7 for demultiplexer and Nonumura (fig 23, 93a buffer and 85, decoder)

**Claim 27** is rejected based on claim 3 and 21. Boyd discloses the second reproducer which can be duplicated like the first reproducer of Nonmura as disclosed in claim 21 above.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Kashiwaga et al (US 6470460) discloses method and an apparatus for

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reproducing bitstream having non-sequential system clock data seamlessly  
there between

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H./  
03/25/2009

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